

*REMARKS/ARGUMENTS**Status of the Application*

Claims 37 to 72 are under examination.

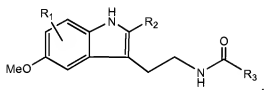
Discussion of the Claim Amendments

Claims 11, 54, 55, 62-29 and 72 are amended to sharpen the claim language. These amendments are supported by the application as filed and, thus, no new matter is introduced by way of these amendments.

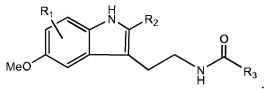
Discussion of the Restriction Requirement

The Office Action alleges a lack of Unity of Invention and sets forth a Restriction Requirement which segregates the claims into the following groups:

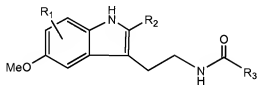
Group I: Claims 37-53, 56-61 and 72 (with claim 72 allegedly identical to claim 37) allegedly drawn to compounds and compositions of the following formula:



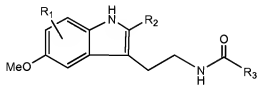
Group II: Claims 54-55 drawn to methods of preparing compounds of the following formula:



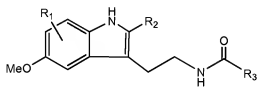
Group III: Claims 62-65 drawn to methods of inducing sedation, hypnosis and/or sleep, or general anesthesia in a patient by administering compounds of the following formula:



Group IV: Claims 66-67 drawn to methods of treating sleep disorders or chronobiological disorders in a patient by administering compounds of the following formula:



Group V: Claims 68-71 drawn to methods of treating a condition affected by melatonin activity in a patient by administering compounds of the following formula:



The requirement of unity of invention is met when there is a technical relationship among those inventions involving one or more of the same or corresponding “special technical features.” “Special technical features” are those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. MPEP § 1850. In reference to “special technical features,” the MPEP offers the example of a lock and key, wherein the key is defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key. MPEP § 1893.03(d).

Applicants submit that because the compounds which comprise the subject matter of claims 37-53, 56-61 and 72 (Group I) are novel, the use of these novel compounds (as set forth in claims 62-71, *i.e.*, Groups III, IV and V) share the same special technical feature with the Group I claims, *i.e.*, the novel structure of the compounds in the claimed genus. Just as the use of a key in a lock has unity of invention with the structure of the key, the uses of the claimed compounds have unity of invention with the compounds themselves.

Further, since the Group II claims *i.e.*, claims 54 and 55, are directed to methods of making the novel compounds, these claims also share the same special technical feature of all the other claims. Additionally, searches for the claimed compounds will also yield references concerning their use or methods of making the compounds, and thus no undue burden should arise from examining all of the pending claims (*i.e.*, Groups I-V) together.

Applicants provisionally elect the Group I claims with traverse. (Applicants also note that claims 37 and 72 are not identical as the Office Action contends. Claim 37 provides that R₁ is hydrogen, a halogen or nitro, while claim 72 provides that R₁ is (only) hydrogen or a halogen.)

The Office Action further alleges that the Group I claim core structure is not a special technical feature because it fails to define a contribution over the prior art, relying on U.S. Patent 6,004,991 ("Fourtillan *et al.*"). The Office Action contends that Fourtillan *et al.* discloses the same core described in claim 1, wherein, *inter alia*, R₂ is MeO and R₃ is H. Applicants submit that the provisionally-elected compounds describe R₂ as 3-trifluoromethylphenyl and R₃ as methyl (see "Discussion of the Election of Species"). Thus, the provisionally elected compounds are substantially different from the compound disclosed in Fourtillan *et al.*

For at least the foregoing reasons, Applicants respectfully request withdrawal of the finding of a lack of unity of invention and the resulting restriction requirement.

Discussion of the Election of Species

As an additional requirement, in view of Applicants' provisional election with traverse of the Group I claims, the Office Action also requires a provisional election of species of a particular compound, which election must include:

- a) the compound name and structure,
- b) the location of the species (a) within the claims or (b) within the specification,
- c) the claims that read on the elected species, and
- d) and a definition of the exact substitutions.

Applicants provisionally elect the Group I compound with the chemical name N-(2-(2-(3-trifluoromethylphenyl)-5-methoxy-1H-indol-3-yl)ethyl)acetamide). This compound is disclosed in claim 47. The elected compound has the following moieties: R₁ is H, R₂ is 3-trifluoromethylphenyl and R₃ is methyl.

Conclusion

Applicants respectfully submit that the application is in proper condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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Date: May 22, 2007